

the central longitudinal axis of the stick head.¹ In support of this amendment and the present application, Assignee/Applicant has cited Figures 2, 4 and 5. As shown most particularly in Figure 2, the end of the mouth portion is clearly shown to be below the longitudinal central axis of the stick head.

In factual support of its position, Assignee/Applicant has further submitted the Declaration of Joseph J. Crisco, a nationally recognized expert in sports orthopedics and lacrosse. In support of his declaration, Dr. Crisco clearly opines that the drawings and most notably Figure 2 clearly supports both the amended claim and specification terminology and would be readily recognized as such by "those skilled in the art".

The United States Court of Appeals for the Federal Circuit has specifically held that the drawings in a patent application may form the basis of a written description under 35 U.S.C. §112.² In Vas-Cath, Inc. v. Mahurkar, et al., 935 F.2d 1555, 1564 (Fed. Cir. 1991), the Federal Circuit clearly stated:

"We agree with the District Court's conclusion that drawings alone may be sufficient to provide the 'written description of the invention' required by §112, first paragraph. Several earlier cases, although not specifically framing the issue in terms of compliance with the written description requirement support this conclusion. For example, we previously stated that 'there is no statutory prohibition against an applicant's reliance in claiming priority under 35 U.S.C. §120 on a disclosure in a design application if the statutory conditions are met.' KangaROOS, U.S.A., Inc. v.

¹ The reissue declaration, rejected by the Examiner, is deemed to be sufficient because it references at least one point of inoperability.

² The written description requirement has often been analyzed in terms of "new matter" under 35 U.S.C. §132, the basis of the present rejection.

Caldor, Inc., 778 F.2d 1571 (Fed. Cir. 1985) ... The issue here is whether there is supporting 'disclosure' and it does not seem, under established procedure of longstanding, approved by this court, to be of any legal significance whether the disclosure is found in the specification or in the drawings so long as it is there. Citing In re Wolfensperger, 133 U.S.P.Q. 541-42 (CCPA 935 F.2d at 1565, 1962). Emphasis added.

In Wolfensperger, the issue presented was whether the specification of the applicant's utility patent application disclosed a ball valve, and whether particularly the drawings thereof supported a claim limitation that read: "having, an untensioned condition, a main diameter corresponding approximately to the mean diameter of said chamber and a radial width smaller than the radial width of the chamber ..."

The court did not agree with the Board's conclusion that recited the "radial width" relationship was not supported by applicant's Figure No. 5:

"The board's statement that 'drawings alone cannot form the basis of a valid claim,' is too broad a generalization to be valid and is, furthermore, contrary to well established and long established patent office practice ... Consider for one thing that the sole disclosure in a design patent application is by means of a drawing ... For another thing, consider that the only informative and significant disclosure in many electrical and chemical patents is by circuit diagrams or graphic formulae constituting drawings' in the case.

Moreover, employing a "new matter" analysis as in the present case, the CCPA in In re Heinle, 342 F.2d 1001 (CCPA 1965), similarly reversed a PTO rejection of the applicant's claims to a "toilet paper core" to "including subject matter having no clear basis in the application as filed." The claim limitation said to be without support in that case required that the width of apertures in the core be "approximately 1/4 of the

circumference of said core.” Having reviewed the application drawings relied upon for support, the court stated:

“It seems to us that [the drawings] conform to 1/4 the circumference limitation almost exactly.” The claim requires only an approximation. Since we believe an amendment to the specification to state that 1/4 of the circumference is the aperture width would not violate the rule against ‘new matter’, we feel that supporting disclosure exists. The rejection is therefore in error.”

In view of the foregoing, the amended claim and specification language is clearly supported by the original disclosure and most notably, Figures 2 and 5. This conclusion is strongly supported by the opinion of a noted expert.³ The present application stands in condition for reissue.

Applicant/Assignee has previously submitted the PTO Assignment Branch documents which establish the chain of title between Ronald J. MacNeil, his wife, Sandra Lynn MacNeil, and Applicant/Assignee Shamrock Lacrosse. The documents are attached hereto for the convenience of the Examiner. A signed statement under 37 CFR 3.73(b) is also enclosed.

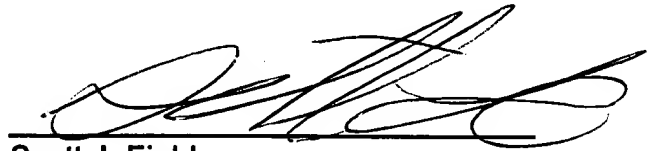
³ In Mahurkar, the opinion of a noted expert was given significant weight in the Court’s determination that the Figures supported the claim language.

CONCLUSION

The claims are in condition for allowance and a Notice of Allowance is earnestly submitted.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read 'Scott J. Fields', is written over a horizontal line.

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